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REMARKS

The Examiner has cited a number of decisions of the Board of Patent Appeals and Interferences and the courts in regard to the rejection of Applicants' claims for lack of enablement under 35 U.S.C. 112, first paragraph. One of these decisions is In re Fisher 166 USPQ18 of the CCPA. In re Fisher is a regularly cited case in Board and court decisions on enablement. Applicants have previously given reasons for why they believe that In re Fisher supports their position that all of Applicants' claims rejected for lack of enablement are in fact enabled.

Applicants herein are presenting an application of In re Fisher to the facts of the present prosecution that they have not previously presented. Applicants are submitting this in a Response After Final rejection in the hope that this new look at In re Fisher may avoid the necessity of filing an appeal brief.

Applicants respectfully requests the Examiner and Supervisor Examiner to reconsider the rejection of Applicants' claims that have been rejected for lack of enablement in view of these new comments on In re Fisher and related decisions of the USPTO Board of Patent Appeals and Interferences and court decisions.

In In re Fisher 166 USPQ 18 two claims (4 and 5) were under appeal. Claim 4 was directed to "A method ... for producing ACTH [adrenocorticotrophic hormones] preparations having potencies ranging from 111% to 230% of standard and containing no more than 0.08 units of vasopressin and no more than 0.05 units of oxytocin per International Unit of ACTH, which limits are said to be tolerable to humans." 166 USPQ 18, 20. "The claim recites that the product must contain 'at least' 24 amino acids in a specified sequence." 166 USPQ 18, 21. To avoid a reference to Li, having a publication date prior to the filing date, the appellant relied on its parent application of which the application under appeal was a continuation-in-part. The CCPA states:

> Appellant's parent application, therefore, discloses no products, inherently or expressly, containing other than 39 amino acids, yet the claim includes all polypeptides, of the recited potency and purity, having

> at least 24 amino acids in the chain in the recited sequence. The parent specification does not enable one skilled in the art to make or obtain ACTH's with other than 39 amino acids in the chain, and there has been no showing that one of ordinary skill would have known how to make or obtain such other ACTH's without undue experimentation. As for appellant's conclusion that the 25th to 39th acids in the chain are unnecessary, it is one thing to make such a statement when persons skilled in the art are able to make or obtain ACTH having other than 39 amino acids; it is quite another thing when they are not able to do so. In the latter situation, the statement is in no way "enabling" and hence lends no further support for the broad claim. We conclude that appellant's parent application is insufficient to support a claim as broad as claim 4. For this reason we affirm the board's rejection of claim 4 as unpatentable over the Li references.

From this statement, it is clear that the reason for why the CCPA did not find the claims under appeal patentable was that the applicant did not teach how to make ACTH with anything but 39 amino acids and there was no evidence in the record that a person of skill in the art knew how to make ACTH with anything but 39 amino acids. It is also clear that if persons of skill in the art knew how to make ACTH with more or less than 39 amino acids, the claims would not have been found not enabled.

In regard to the rejection of Fisher claims 4 and 5 for lack of enablement the CCPA states:

> We have already discussed, with respect to the parent application, the lack of teaching of how to obtain other-than-39 amino acid ACTHs. That discussion is fully applicable to the instant application, and we think the board was correct in finding insufficient disclosure due to this broad aspect of the claims. 166 USPQ 18, 23.

Thus the claims in Fisher were found not enabled because the Fisher application did not teach how to make "other-than-39 amino acid ACTHs" and there was no evidence in the record that persons of skill in the art knew how to make "other-than 39 amino acid ACTHs."

In regards t the rejection for enablement, the CCPA further states:

> The issue thus presented is whether an inventor who is the first to achieve a potency of greater than 1.0 for certain types of compositions, which potency was long desired because of its beneficial effect on humans, should be allowed to dominate all such compositions having

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> potencies greater than 1.0, including future compositions having potencies far in excess of those obtainable from his teachings plus ordinary skill. 166 USPQ 18, 23.

Thus the CCPA rhetorically asks the question whether the first person to discover a composition having a potency greater than 1 where such potency is of significant value should be allowed a claim "including future compositions having potencies far in excess of those obtainable from his teachings plus ordinary skill."

The CCPA answers this rhetorical question stating:

> It is apparent that such an inventor should be allowed to dominate the future patentable inventions of others where those inventions were based in some way on his teachings. 166 USPQ 18,24

From this statement is clear that applicants such as the Applicants of the present